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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/620,400	07/15/2003	Joe F. Wells	5823-70103	9550
23643 7:	590 12/28/2004		EXAMINER	
BARNES & THORNBURG			TRUONG, THANH K	
11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			ART UNIT	PAPER NUMBER
	•		3721	
			DATE MAIL ED: 12/20/2007	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	7
	10/620,400	WELLS, JOE F.	
Office Action Summary	Examiner	Art Unit	
	Thanh K Truong	3721	
The MAILING DATE of this communication a Period for Reply	appears on the cover sheet w	ith the correspondence address	
A SHORTENED STATUTORY PERIOD FOR REF THE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a I - If NO period for reply is specified above, the maximum statutory peri - Failure to reply within the set or extended period for reply will, by sta Any reply received by the Office later than three months after the ma earned patent term adjustment. See 37 CFR 1.704(b).	N. 1.136(a). In no event, however, may a reply within the statutory minimum of thir od will apply and will expire SIX (6) MOI tute, cause the application to become Al	reply be timely filed ty (30) days will be considered timely. NTHS from the mailing date of this communication BANDONED (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on 11	October 2004.		
2a)⊠ This action is FINAL . 2b)□ T	his action is non-final.		
3) Since this application is in condition for allow closed in accordance with the practice unde	· ·	·	
Disposition of Claims			
4) ☐ Claim(s) 14-33 is/are pending in the applicated 4a) Of the above claim(s) is/are withd 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 14-33 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and application Papers 9) ☐ The specification is objected to by the Examination Papers	rawn from consideration. d/or election requirement.		
10) The drawing(s) filed on is/are: a) a		by the Evaminer	
Applicant may not request that any objection to the	· · · · · · · · · · · · · · · · · · ·	·	
Replacement drawing sheet(s) including the corn	• • • • • • • • • • • • • • • • • • • •).
11) The oath or declaration is objected to by the	•		,
Priority under 35 U.S.C. § 119			
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority docume 2. Certified copies of the priority docume 3. Copies of the certified copies of the priority application from the International Bure * See the attached detailed Office action for a lie	ents have been received. ents have been received in A riority documents have been eau (PCT Rule 17.2(a)).	pplication No received in this National Stage	
Attachment(s)			
Notice of References Cited (PTO-892)		Summary (PTO-413)	
 Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/0 Paper No(s)/Mail Date 	a. 🗖	s)/Mail Date nformal Patent Application (PTO-152) 	

Page 2

Application/Control Number: 10/620,400

Art Unit: 3721

DETAILED ACTION

1. This action is in response to applicant's amendment received on October 11, 2004.

2. Applicant's cancellation of claims 1-13 is acknowledged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 32 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 32 is a dependent claim of claim 21, and claim 21 claims an apparatus that is pneumatically operated in both directions, however, claim 32 further claims that the device of claim 21 further comprises a manual actuator. The applicant's disclosure provides no support for a device that is having both pneumatic actuator and manual actuator in the same embodiment.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed above in paragraph 2 of this office action, from the applicant's disclosure, the pneumatically operated device and the manually operated device are not of the same embodiment. In other words, Applicant cannot claim a pneumatic apparatus and in the same claim claiming that the pneumatic apparatus also a manually operated device. Claim 32 is vague and indefinite, because it is unclear what is being claimed, a pneumatic driven piston device or a manually operated piston device. Furthermore, the device discloses by the Applicant can only be operated either as a manually operated device or a pneumatic operated device, but not both as the same time.

Accordingly, claim 32 cannot be treated on its merits at this time.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

8. Claims 14, 17-19, 21-26 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Fehrs (3,583,496).

Fehrs discloses an apparatus (figures 1-3) comprising:

Art Unit: 3721

a magazine 79 configured to hold a plurality of fasteners and having an opening through which the fasteners are fed;

a pneumatic cylinder 2 having an upper portion and a lower portion, the cylinder being in fluid communication with a source of compressed gas;

a piston 5 having an upper end and an opposite lower end, the piston being disposed within the cylinder and moveable relative therto;

a drive member 6 coupled to the piston and moveable therewith in a first direction across the opening of the magazine 79 by the compressed gas entering the upper portion of the pneumatic cylinder (figure 2) to drive a fastener into the ground, and moveable in an opposite second direction (figure 3) across the opening by compressed gas entering the lower portion of pneumatic cylinder.

Fehrs further discloses: a control apparatus 4 for controlling the actuator, and the control apparatus including a pneumatic valve 25, 42; the two pneumatic valves have a first default position and a second position (figures 1-3 show valves 25 and 42 move from default position to second position); the pneumatic actuator comprises a charging chamber 30, 76; the control apparatus in fluid communication with the charging chamber and the pneumatic cylinder and configured to control the introduction of compressed gas into the pneumatic cylinder (figures 1-3); the control apparatus 4 is disposed between the charging chamber 30 and the pneumatic cylinder 2; and the control apparatus comprises a first valve 25 configured to direct compressed gas into the upper portion of the pneumatic cylinder to drive the piston in the first direction and a

second valve 42 configured to direct compressed gas into the lower portion of the pneumatic cylinder to drive the piston in the second direction.

Claim Rejections - 35 USC § 103

- 9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 10. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehrs (3,583,496) in view of Lange (3,929,056).

As discussed above in paragraph 8 of this office action, Fehrs discloses the claimed invention, but does not expressly disclose that both of the control valves must be actuated in order to move plunger in the pneumatic cylinder.

Lange discloses an apparatus comprising a control apparatus for controlling the actuator and the control apparatus including two pneumatic valves 14, 15; wherein both valves must be actuated in order to move a plunger in the pneumatic cylinder (figure 4 & column 3, lines 20-34). Lange device provides a safety feature to protect the operator from accidentally activates the device.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fehrs apparatus by incorporating the control device as taught by Lange to provide safety feature to protect the user of the device.

Art Unit: 3721

11. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehrs (3,583,496) in view of Dorney (3,215,324).

As discussed above in paragraph 8 of this office action, Fehrs discloses the claimed invention, but does not expressly disclose that the magazine is removable and is configured to house fasteners of different dimension.

Dorney discloses an apparatus that the magazine is removable and is configured to house fasteners of different dimension (column 1, lines 9-18, lines 28-31 and lines 55-57). Dorney apparatus provides flexibility to the pneumatic fastener.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fehrs apparatus by incorporating the removable magazine as taught by Dorney providing flexibility to the pneumatic fastener.

12. Claims 14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange (3,929,056).

Lange discloses a fastener insertion device 1 for inserting fasteners in a substrate, the device comprising: a pneumatic actuator 4, 5; a fastener holder 7 configure to hold a plurality of fasteners (column 2, lines 28-29 & lines35-36); a fastener pusher 6 coupled for movement relative to the fastener holder, the fastener pusher being configured to engage an end of a fastener (figure 1 & lines 35-38); an actuator 4, 5 coupled to the fastener pusher, the actuator being configured to move the fastener pusher between an extended fastener-inserting position and a retracted position.

Lange further discloses: charging chamber 3; a control apparatus for controlling the actuator and the control apparatus including two pneumatic valves 14, 15; wherein both valves must be actuated in order to move a plunger in the pneumatic cylinder (figure 4 & column 3, lines 20-34); wherein the two pneumatic valves have a first default position and a second position, the actuator is actuated when the two pneumatic valves are in their second position (figures 1-4); wherein compressed air biases the plunger in the uppermost position (figure 1); a second actuator 14 including a handle 2 and an operator-driven piston 16 coupled to the handle (figures 1-4).

13. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Lange (3,929,056) in view of Dorney (3,215,324).

As discussed above in paragraph 12 of this office action, Lange discloses the claimed invention, but does not expressly disclose that the magazine is exchangeable with a second fastener holder.

Dorney discloses an apparatus that the magazine is exchangeable and is configured to house fasteners of different dimension (column 1, lines 9-18, lines 28-31 and lines 55-57). Dorney apparatus provides flexibility to the pneumatic fastener.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fehrs apparatus by incorporating the removable magazine as taught by Dorney providing flexibility to the pneumatic fastener.

Art Unit: 3721

14. Claims 14, 16-26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (4,627,563) in view of Fehrs (3,583,496).

Meyer discloses an apparatus comprising: a pneumatic actuator 50; a fastener holder 130 configure to hold a plurality of fasteners 160; a fastener pusher 76 coupled for movement relative to the fastener holder, the fastener pusher being configured to engage an end of a fastener (figure 3); an actuator 50 coupled to the fastener pusher, the actuator being configured to move the fastener pusher between an extended fastener-inserting position (figure 5) and a retracted position (figure 2).

Meyer further discloses: charging chamber 52; and a control apparatus 90 including a pneumatic valve.

Meyer discloses the claimed invention, but does not expressly discloses that the pneumatically driven piston being biased by compressed air to move the fastener pusher.

As discussed above in paragraph 8 of this office action, Fehrs discloses an apparatus in which the pneumatically driven piston being biased by compressed air to move the fastener pusher.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Meyer so that the pneumatically driven piston is biased by compressed air to move the fastener pusher as taught by Fehrs. Fehrs apparatus provides a better and more effective device (column 1, lines 20-23).

15. The modified Meyer (and Fehrs) further discloses all the features as recited in claims 14, 17-19, 21-26 and 33 (see paragraph 8 of this office action).

Conclusion

- 16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- 17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (571) 272-4472. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

Art Unit: 3721

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt December 15, 2004.

Rinaldi I. Rada Supervisory Patent Examiner Group 3700